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YAMAHA HATSUDOKI KABUSHIKI KAISHA
C/O KEATING & BENNETT, LLP
8180 GREENSBORO DRIVE
SUITE 850
MCLEAN, VA 22102

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| EXAMINER |
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DICUS, TAMRA

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| ART UNIT | PAPER NUMBER |
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1774

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|------------|---------------|
| 3 MONTHS | 04/03/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/509,369

Applicant(s)

SUZUKI ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-59 and 90-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-59 and 90-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The RCE is acknowledged.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the decorative pattern area must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show 2, and 2a in FIG. 4 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 93 is objected to because of the following informalities: “and to not overlap the pattern area”, appears grammatically incorrect, a suggestion: “and does not overlap the pattern area”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44 and 92 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claims 44 and 92 claim the resin material spreads to follow an uneven surface, while in line with the instant specification and drawings (FIG. 4 in particular), show only a decorative sheet 10 and not any structural layer that spreads to follow, thus including that it is the resin layer that spreads to follow is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42-93 are not clear because “the spread suppressing member is arranged so as to overlap only a portion of the base” is not commensurate with the instant specification and drawings. As the drawings show the spread suppressing member only on the pattern layer, nowhere does it show the member on a pattern and on a portion of the base. “Overlap” is commonly used to extend over or past and cover a part of something. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the

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uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Claim 42 is unclear because it recites a continuous decoration layer having a pattern area and pattern. It is not common to recite a continuous decoration layer with a pattern because patterns are discontinuous and if the pattern is comprised of the decoration layer, it cannot mean the layer is continuous. Claim 57 has similar issues.

Claim 42 is unclear because a spread suppressing member is provided at a location "corresponding" to a first surface or on the side of a second for suppressing the pattern as claimed, it is not clear exactly where the pattern is in relation to the first surface and it is not clear how the suppressing member suppresses the pattern if it's on a second side. Claim 57 has similar issues.

Claims 44 and 92 are unclear because they recite, "that spreads to follow an uneven surface", "spreads to follow" is vague and not clear as to the exact meaning. It is not clear how a material spreads to follow a surface, further if there is no actual attachment because of the intended suggestive language ('is to be attached').

Claims 46 and 48 recite "including one of a metal and a metal compound". It is not clear if it is a mixture compound or an attempt to list individual materials. If the later is so, the language is not an acceptable Markush group listing. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126

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(Comm'r Pat. 1925). Suitable language to include would be {"wherein the X are selected from the group consisting of". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 42 is rejected under 35 U.S.C. 102(e) as being anticipated by Kauppi et al.

Kauppi teaches instant Claim 42: A decorative sheet comprising: a deformable base (translucent resin 504, Fig. 5 and associated text) member having first and second principal surfaces opposed to each other; a continuous decoration layer (ink, 502, Fig. 5 and associated text) provided directly on the first principal surface of the base member and having a pattern area representing a predetermined pattern (print), the decoration layer being defined by an ink layer that is visible from a direction perpendicular to a plane including the ink layer (translucent base 903 allows this effect); and a spread suppressing member (foil 501, Fig. 5 and associated text) provided at a location corresponding to the pattern area on the side of the first principal surface or on the side of the second principal surface of the base member, for suppressing the spreading of the pattern area of the decoration layer (is to intended use, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not

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differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).); wherein the spread suppressing member is arranged so as to overlap only a portion of the base member (see structure in Fig. 5) and is made of a material (polycarbonate) that suppresses the spreading of the pattern area of the decoration layer (because 501 is adjacent to 502, it meets this function). Claims 42-43 are met.

Claims 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaynes.

Jaynes teaches a multilayered foil laminate having a metal foil 12 (suppressing member of metal), printing 13 (continuous decoration ink layer in a pattern), and PVC base 17 (base made of resin) (FIG. 1 and associated text). Because the same structure and materials are provided the functional language (that is visible from a direction, that suppresses the spreading, for suppressing pattern area) of the instant claims 42-44 are met.

Claims 42-50, 56, 59, 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Eichelberger et al.

Eichelberger teaches a decorative sheet (FIG. 1) comprising a metal 102 (suppressing member of metal), printed ink 101 (continuous decoration ink layer in a pattern), and polymeric substrate 100 (base made of polyesters, polystyrene, known PET, epoxy) (FIG. 1 and associated text, 2:1-2, 4:19-21). Because the same structure and materials are provided the functional

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language (that is visible from a direction, that suppresses the spreading, for suppressing pattern area, spreads to follow) of the instant claims 42-50, 90-91, and the respective properties (thermal coefficient recitations, translucency) are met.

The furthest point of 102 extending laterally across toward the ink 101, but right before the ink 101 is considered the second portion circumference not overlapping the pattern area (same as Applicant's instant FIG. 5 shows) (per instant claims 52-53

Regarding claim 56, Eichelberger teaches the molded and decorative sheet set forth above, but not the intended use toward a molded article comprising the decorative sheet and body1. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 59, Eichelberger teaches the molded and decorative sheet set forth above, but not intended use toward a motor vehicle comprising the molded article. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51, 54-55, 57-58, 92-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichelberger et al. as applied to claim 42 above.

Eichelberger essentially teaches the claimed invention as set forth above, but does not teach a range as recited in instant claims 51, 54-55, and 57-58.

However, Eichelberger does not state the thickness as recited. However, it would have been obvious to one of ordinary skill in the art to produce a thickness as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the degree of light shielding (col. 4, lines 55-60 of Mori).

Regarding claim 59, Eichelberger teaches the molded and decorative sheet set forth above is a part of molding, but not intended use toward a motor vehicle comprising the molded article. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 42-59, 90-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auld et al.

Auld teaches a decorative emblem (decorative sheet, FIG. 2 and associated text) having print 16, 12 (continuous ink layer having pattern) over and under transparent plastic 17, 20, 19, 13 (deformable base), and where 13 can be metal or a metallized layer (suppressing member), and has an additional embedded image.

The width relationship of the metallized layer is not mentioned (claims 42, 52-55, 57, 92-93), however, changing the width of the metal to overlap only a portion of the base is an optimizable feature as changing the size is not patentably significant. It would have been obvious to one having ordinary skill in the art to have modified Auld to position the suppressing metal as claimed in order to achieve a desired design effect. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

To the thickness requirements (claims 54-55, 57-58, 93), it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 56, Auld teaches the molded and decorative sheet set forth above, but not the intended use toward a molded article comprising the decorative sheet and body1. However, it has been held that a recitation with respect to the manner in which a claimed

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apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 59, Auld teaches the molded and decorative sheet set forth above, but not intended use toward a motor vehicle comprising the molded article. However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further the emblem is attached to a motor vehicle or molded body is an obvious modification as Auld teaches it is an emblem having release and adhesive layers for attaching to any surface, a car is an obvious choice. See also Auld teaching decorative emblems known for attaching to cars (10-20).

Claims 56, 59, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auld et al. in view of Watanabe et al.

Auld essentially teaches the claimed invention applied above.

Auld does not expressly teach attaching the decorative sheet to a molded article or motor vehicle.

Watanabe teaches a car part shell body covered with patterned plastic for beautification of the outer surface (Abstract).

It would have been obvious to one having ordinary skill in the art to have modified the emblem of Auld to adhere to a molded article or motor vehicle resulting in claims 56, 59, and 57

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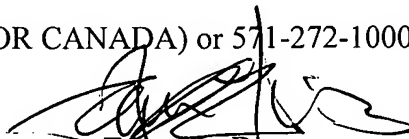
because Watanabe teaches decoration of car parts result in beautification of the outer surface (Abstract, col. 2, Examples).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

March 21, 2007



RENA DYE
SUPERVISORY PATENT EXAMINER
AU 1774